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Paper No. 26
CEW

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Ricardo Arregui

Serial No. 74/540,041

Marvin Petry of Larson & Taylor for applicant.

David C. Reihner, Trademark Examining Attorney, Law Office
107 (Thomas Lamone, Managing Attorney).

Before Cissel, Hanak and Walters, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

Ricardo Arregui has filed a trademark application to register the mark shown below for "rum and rum specialty drinks."¹ The application includes a disclaimer of "RUM" apart from the mark as a whole.

¹ Serial No. 74/540, 041, in International Class 33, filed June 20, 1994, based on a bona fide intention to use the mark in commerce. Applicant states that "the drawing is lined for the colors gold, red and blue"; and that "the mark consists of the words "Old Havana Rum" and the design of a crest containing a turret and palm tree with sugar canes, a bar and a scroll."



The Trademark Examining Attorney has issued a final refusal to register under Section 2(e)(3) of the Trademark Act, 15 U.S.C. 1052(e)(3), on the ground that applicant's mark is primarily geographically deceptively misdescriptive in connection with its proposed goods.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested.

In order for registration to be properly refused under Section 2(e)(3), it is necessary to show that (i) the mark sought to be registered is the name of a place known generally to the public; and that (ii) purchasers are likely to believe, mistakenly, that the goods or services sold under applicant's mark have their origin in or are somehow connected with the geographic place named in the mark. *In re Nantucket, Inc.*, 677 F.2d 95, 213 USPQ 889 (CCPA 1982).

See also, In re California Pizza Kitchen, Inc., 10 USPQ2d 1704 (TTAB 1988), citing *In re Societa Generale des Eaux Minerals de Vittel S.A.*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987).

Mark Conveys Primarily Geographic Connotation

With regard to the first prong of the test, there is no genuine issue that HAVANA is the name of a major city in Cuba, and that it is Havana, Cuba, that will come to mind upon viewing the mark. Further, we conclude that the additional terms, OLD and RUM, and the design matter added to the mark do not detract from the primary geographic significance of the composite mark. *See In re Bacardi & Company Limited*, 48 USPQ2d 1031 (TTAB 1997); and *In re Chalk's International Airlines Inc.*, 21 USPQ2d 1637, 1639 (TTAB 1991). As the Board has stated in the past, the determination of registrability under Section 2(e)(3) [previously, Section 2(e)(2)] should not depend on whether the mark is unitary or composite. *See In re Cambridge Digital Systems*, 1 USPQ2d 1659, 1662 (TTAB 1986).

The addition of the term OLD to the geographic term HAVANA simply either describes a characteristic of the city or refers to a section of the city. Thus, OLD reinforces the geographic significance of the composite mark. The term RUM is the generic term for the identified goods and does nothing to detract from the geographic significance of the

composite mark. Similarly, the scroll at the bottom of the mark is simply a carrier for other information and the bar at the top of the mark is merely a border design. As the Examining Attorney establishes through dictionary, gazeteer and encyclopedia evidence, the palm tree and sugar cane designs suggest Havana, as does the tower design, which is reminiscent of Morro Castle at the mouth of Havana Harbor. Thus, we find that these design elements also reinforce the geographic significance of OLD HAVANA.

To summarize, the composite mark conveys primarily a geographic connotation.

Goods/Place Association.

We turn, then, to the question of whether purchasers are likely to make a goods/place association between the geographic place named in applicant's mark and the identified goods. We answer that question in the affirmative. The Examining Attorney has submitted evidence from dictionaries, encyclopedias and gazetteers indicating that HAVANA, Cuba, is a major city which produces a variety of goods, among which "rum" is listed as a significant product. We find sufficient evidence herein to conclude that a goods/place association is likely to be made by purchasers between HAVANA, the major city in Cuba, and the rum products identified in this application. Thus,

purchasers are likely to believe that the rum products to be sold under the mark herein originate in HAVANA, Cuba.²

Therefore, we conclude that applicant's mark is primarily geographically deceptively misdescriptive because the mark is the name of a place, Havana, Cuba, that is known generally to the public; and purchasers of applicant's goods are likely to believe, mistakenly, that these goods have their origin in or are somehow connected with Havana, Cuba. Applicant's arguments are not persuasive of a different result.

Decision: The refusal under Section 2(e)(3) of the Act is affirmed.

² Applicant argues, essentially, that because of the existing trade embargo on products from Cuba, consumers are not likely to believe that applicant's goods originate in Cuba. However, we must apply the trademark law notwithstanding the existence of the embargo. The evidentiary record herein supports the conclusion that a goods/place association exists between Havana, Cuba, and rum.